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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,523	09/15/2000	Veronique Roulier	6388-0518-0	9437

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EXAMINER

BERMAN, ALYSIA

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 07/03/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/555,523	<b>Applicant(s)</b> ROULIER ET AL.	
	<b>Examiner</b> Alysia Berman	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 April 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12, 13, 15-32 and 34-38 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13 and 30-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 15-29 and 34-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

1. Receipt is acknowledged of the amendment filed April 3, 2002. Claims 1 and 20 have been amended. Claims 14 and 33 have been canceled. Claims 1-10, 12, 13, 15-32 and 34-38 are pending. Claims 12, 13 and 30-32 have been withdrawn as directed to a non-elected invention in the Office Action mailed December 18, 2001, paper no. 9.

The status of claims 1-10, 15-29 and 34-38 is as follows.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 20-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is maintained for reasons of record in paper no. 9.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-10, 15-29 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09255529 A (JP '259) in combination with US 5,326,484 (484).

JP '529 is directed to oil-in-water emulsions that contain an alkyl acrylate/methacrylate copolymer and do not contain a surfactant. The copolymer is Pemulen® TR-1 or Pemulen® TR-2 (HCAPLUS abstract). The average particle size of the oily phase of the emulsion is not more than 1 micron (Derwent and HCAPLUS abstracts). The amount of copolymer in the emulsion is from 0.01-10 wt.% and the amount of oily phase is from 0.5-20 wt.% (Derwent and JPAB abstracts).

JP '259 does not teach that the oily globules are monodispersed (claims 1 and 20), the amount of monomers in the copolymer (claims 2 and 21), the formula of the monomers in the copolymer (claims 3 and 22) or the viscosity of the copolymer (claims 15, 16, 31, 32, 34 and 35).

US '484 is directed to monodispersed emulsions (title and abstract). US '484 teaches that non-monodispersed emulsions exhibit poor stability and require large amounts surfactants to improve the stability (col. 1, lines 27-34). The emulsions of US

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'484 overcome these disadvantages. US '484 teaches at column 9, lines 29-35 that the emulsions can be used in cosmetics.

Applicant discloses at page 5, lines 14-22, that Pemulen® TR1 and Pemulen® TR2 exhibit the instantly claimed viscosities. Because these are disclosed as preferred copolymers of Applicant, it is presumed that these polymers meet the limitations of the weight percent ranges of monomers and monomer formulas as instantly claimed.

Burden is shifted to Applicant to show that the copolymers of the prior art do not exhibit these properties or characteristics.

It would have been obvious to one of ordinary skill in the art at the time of the invention to monodisperse the emulsion of JP '259 as taught by US '484 expecting to obtain a more stable emulsion without the use of surfactants.

### ***Response to Arguments***

7. Applicant's arguments with respect to the 35 U.S.C. 102(b) rejection of claims 1-10, 14-29 and 33-38 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments filed April 3, 2002 with respect to the 35 U.S.C. 112, 1<sup>st</sup> paragraph rejection of claims 20-29 and 33-38 have been fully considered but they are not persuasive.

9. Applicant argues that support for claims 20-29 and 33-38 that do not exclude surfactants is supported by the background information provided on the general state of emulsions and by the disclosure that common cosmetic additives may be contained in the emulsions. This is not found persuasive because Applicant explicitly excludes

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surfactants from the instant invention at page 2, lines 8-27. None of the examples provided by Applicant contains a surfactant. Applicant does not disclose surfactants as one of the common additives that may be contained in the instant emulsion. It is clear from Applicant's disclosure that Applicant's intent is to exclude surfactants from the emulsions. Therefore, it does not appear that Applicant had possession of the instantly claimed invention at the time the application was filed.

10. The 1.132 Declaration filed April 3, 2002 has been considered but is not found persuasive. Applicant has not provided any data in order to determine unexpected results over the prior art. It is within the skill in the art to make monodispersed emulsions as evidenced by US '484. The fact that Applicant obtains a monodispersed emulsion using the method disclosed in the instant specification is not unexpected over the prior art. Further, it is not unexpected for a monodispersed emulsion to be more stable than a non-monodispersed emulsion without the use of surfactants.

With respect to the argument that the emulsion of JP '259 is solid, the claims do not exclude a solid emulsion. The composition of JP '259 contains all of the components instantly claimed within the instantly claimed amounts. Applicant has not provided any limitations in the claims or evidence of record that the emulsion of JP '259 is different from the instantly claimed emulsion.

With respect to the argument that the emulsion of JP '259 does not provide a pleasant feel when applied, this is a relative feature that does not provide patentability to the claims. The feature of providing a pleasant feel upon application cannot be quantitatively measured or compared. The Examiner has no way of determining

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whether the instant emulsion provides a pleasant feel and that the emulsion of the prior art does not. Showings of facts are much preferred to statements of opinion. *In re Oelrich*, 198 USPQ 210, 215 (CCPA 1978).

### ***Unexpected Results***

11. It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, the data presented in the 1.132 Declaration filed April 3, 2002 does not show unexpected results over the prior art.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alysia Berman  
Patent Examiner  
~~October 15, 2002~~  
June 20,